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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,167	09/23/2003	Andrew Bradbury	021362-000300US	2827
20350	7590	09/12/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			BORIN, MICHAEL L	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			1631	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,167

Applicant(s)

BRADBURY ET AL.

Examiner

Michael Borin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

Claims 1-59 are currently pending.

### **Restriction Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to a bifunctional polypeptide, classified in class 530, subclass 350.
- II. Claims , drawn to multifunctional polypeptide, classified in class 530, subclass 350.
- III. Claims 37-44, drawn to first kit containing fragments of polypeptide of Group I, classified in class 435, subclass 810+.
- IV. Claims , drawn to second first kit containing fragments of multifunctional polypeptide, classified in class 435, subclass 810+.
- V. Claim 55, drawn to method of making a multifunctional polypeptide of Group II, classified in class 530, subclass 333.
- VI. Claim 56, drawn to first method of screening, classified in class 435, subclass 7.1.
- VII. Claim 57, drawn to second method of screening, classified in class 435, subclass 7.1.
- VIII. Claim 56, drawn to third method of screening, classified in class 435, subclass 7.1.

IX. Claim 56, drawn to fourth method of screening, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and II are patentably distinct from each other because of the materially different structures of the compounds they are claiming. The product of Group I is a bifunctional product comprising comprises binding ligand linked to a first member of a coil-coil binding pair and a reporter molecule linked to the second member of a coil-coil binding pair, whereas the product of Group is a multifunctional polypeptide comprising polypeptide that undergoes spontaneous multimerization to form a self-assembled complex – the latter not being required for the product of Group I.

Polypeptides of Groups I and II and kits of Groups III and IV are independent inventions as the kits do not utilize products of Groups I or II; rather, they are containing fragments of said polypeptides.

Products of Groups I-IV and methods of Groups VI,VIII,VII, IX are respectively related as product and process of use. The products as claimed can be used in a materially different processes such as peptide synthesis or raising antibodies.

Inventions V and II are related as process of making and product made. The product of Group II can be made by a variety of alternative methods of peptide synthesis.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and necessity for non-coextensive patent, structure, and literature searches restriction for examination purposes as indicated is proper.

### **Election of Species Requirement**

Election of species should be required prior to a search on the merits in all applications containing both species claims and generic or Markush claims.(MPEP 808.01(a))

If any one of Groups I-IV is elected, applicant is further required to elect from plurality of disclosed patentably distinct species of:

- A. Binding ligands (e.g., as in claims 5-7, for Group I).
- B. Reporter molecules (e.g., as in claims 8-11, 12-14, 15, and 16-17, for Group I).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

To be complete, a response to the election of species requirement should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. MPEP 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D., can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 Michael Borin, Ph.D.  
Primary Examiner  
Art Unit 1631

mlb